

Application No. 10/026,364**Atty Docket No. JGR 1007-1****REMARKS**

Claims 1-44 are pending in this application. Claims 1-42 are currently rejected by the Examiner. Claim 5 is rejected under 35 USC § 112. The remaining claims are rejected under 35 USC § 103. Claims 43 and 44 are new.

Objection to Claim Numbering

The Examiner's numbering of the unnumbered claim 42 is noted with appreciation and has been adopted.

Claim Rejections Under 35 USC § 112

The Examiner rejects claim 5 under 35 USC § 112, second paragraph, noting a typographical error, which has been corrected by amendment. The same typographical error has been corrected in claim 34. The correct usage appears in the application at [0049] & [0052].

Rejection Under 35 U.S.C. § 103(a) of Claims 1-29

The Examiner rejects claims 1-29 under 35 U.S.C. § 103(a) as unpatentable over Ogbuji, Validating XML with Schematron (2000) ("Ogbuji") in view of Harold et al., XML in a Nutshell (2001) ("Harold").

Applicants will repeatedly emphasize that neither Ogbuji nor Harold describes **updating** a self-describing, structured document. Applicants acknowledge that XML is one example of a self-describing, structured document on which both Ogbuji's Schematron and Harold's XSLT operate. Schematron uses XSLT (Ogbuji, at 4 ¶ 2), so Harold's description of XSLT cannot really add anything to how Schematron's authors decided to apply XSLT, though it can explain features of XSLT that Ogbuji assumes the reader will understand. A user writes a "Schematron schema" (*id.*, at 7-8), effectively supplementing an XML schema that defines the structure of an XML document. A Schematron XSLT stylesheet is used to convert the Schematron schema into a "validating stylesheet." *Id.* The validating spreadsheet is used to validate an instance of the XML document. When the validating stylesheet is applied to the document, the output is an error list. *Id.*; *id.* at 6 ¶ 2. Nothing in Ogbuji suggests using Schematron to **update** XML documents in place (*see, e.g.*, the application [0060]), as opposed to

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scanning XML documents for mistakes and reporting separately the validation results. The word "update" does not even appear in Ogbuji, according to a text search.

Claim 1

Claim 1 includes the limitations:

receiving a character string including one or more sets of:

an update operator;

a path specification identifying a node at which the update operator is to be applied; and

one or more update values;

parsing the character string;

accessing a self-describing, structured document; and

updating said document with the update values at the path specification.

These limitations are not found in Ogbuji in view of Harold. The Examiner admits that "Ogbuji fails specifically to disclose ... [a]n update operator [or] [o]ne or more update values." OA, at 4. Inexplicably, the Examiner nonetheless claims that Ogbuji discloses, "A path specification identifying a node at which the update operator is to be applied." *Id.* Just on face value, it is implausible that a path specification for applying an update operator would be disclosed by a reference that admittedly does not address updating. Ogbuji does not read on the path specification sub-element as claimed. While Ogbuji does discuss XPath query patterns, it does not apply them to updating XML documents.

Harold does not supply the update step, operator or value that is from Ogbuji. The Examiner refers to discussion by Harold, at 7, of wildcards. OA, at 4. As one would suspect on general principle, Harold uses wildcards to search and "match different element and node types". Searching is not updating. XPath is a searching syntax and XSLT is a transformation language that produces a distinct output file, not an update to an XML document. Neither XPath nor XSLT updates a particular XML document.

Therefore, claim 1 should be allowable over Ogbuji in view of Harold.

Claims 2-3

Claims 2-3 include the limitations:

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wherein the character string further includes a document ID

wherein accessing the document includes retrieving the document based on the document ID

These limitations are not found in Ogbuji in view of Harold. The Examiner reasons, "Ogbuji further discloses the method wherein the character string further includes a document ID (page 5, paragraphs 1-2: Here, a URL is used as a document ID)."

However, the passage of Ogbuji on which the Examiner relies :

Structure of a Schematron Document

A Schematron XML document consist of a *schema* element in the Schematron namespace: *http://www.ascc.net/xml/schematron*. The *schema* element contains one or more *pattern* elements. Pattern elements allow the user to group schema constraints logically. Some examples of logical groupings are: Text Only Elements, Valid Root Element, Check for ID Attribute.

Pattern elements have a *name* attribute. They may also have a *see* attribute that refers to a URL for user documentation of the schema.

The URL in this passage is not a Document ID, it is a schema namespace base for locating schema elements, which is not as claimed.

The Examiner further reasons that Harold discloses using a document ID implied by prior state information. OA, at 5. "Ogbuji further discloses the method wherein accessing the document includes retrieving the document based on the document ID (page 5, paragraphs 1-2: Here, the URL is retrieved for the user documentation of the schema)." The paragraphs set out above does not include using a document ID to retrieve a document.

Therefore, claims 2 and 3 should be allowable over Ogbuji in view of Harold.

Claim 4

Claim 4 includes the limitation:

wherein a document ID is implied by prior state information

This limitation is not found in Ogbuji in view of Harold. The Examiner argues, "[P]age 3, section 'Location Paths': Here, based upon the prior state location, the root location path is implied. A user need only enter a '/' instead of entering an absolute path." The

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discussion of "Location Paths" addresses navigating nodes within an XML document using XPath. There is nothing inherent in or implied by selecting a node within a document that requires selecting the document using a document id, as claimed.

Therefore, claim 4 should be allowable over Ogbuji in view of Harold.

Claims 5-14

Claims 5-14 should be allowable for at least the same reasons as claim 1 and other claims from which they depend.

Claims 15-18

Claims 15-18 include the limitations:

further including accessing an element set list corresponding to a plurality of the update values to be applied at the path specification

This sort of macro facility that invokes an element set list corresponding to multiple update values is not found in Ogbuji in view of Harold.

Therefore, claims 15-18 should be allowable over Ogbuji in view of Harold.

Claims 19-29

Claims 19-29 include the limitations relating to an update operator and updates values, which are not found in Ogbuji in view of Harold.

Therefore, claims 19-29 should be allowable over Ogbuji in view of Harold.

Applicants respectfully submit that claims 1-29 should be allowable over Ogbuji in view of Harold.

Rejection Under 35 U.S.C. § 103(a) of Claims 30-42

The Examiner also rejects **claims 30-42** under 35 U.S.C. § 103(a) as unpatentable over Ogbuji in view of Harold.

Claim 30

Claim 30 includes the limitations:

receiving a request identifying a starting document and specifying a document type to be generated from the starting document;

accessing at least first and second declarative transformations corresponding to the starting document and the specified document type;

applying the first declarative transformation to the starting document,

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producing a resulting document of the specified document type;
applying the second declarative transformation to the resulting document,
producing character string data including a plurality of
path specifications for nodes in the resulting document;
starting values copied from the starting document for at least some of the
nodes; and
editable values for at least some of the nodes;
responding to the request with the character string data;
receiving an updated version of the character string data; and
producing an updated resulting document corresponding to the updated
version of the character string data.

These limitations are not found in Ogbuji in view of Harold. In one embodiment, this describes transforming one document (e.g., a purchase order) into another (e.g., a purchase order acknowledgement) using a GUI interface with XML or HTTP fields, from the perspective of a server. The server receives the starting document ID and performs a two-stage transformation to set up an editable instance of the new document type, then responds to edits at the GUI by updating the new document.

Neither Schematron's validation nor XSLT operate as claimed. The Examiner argues that Ogbuji producing a validation report matches many of the claimed elements. To extend Ogbuji, one would need to make the validation report editable and have some reason to perform the responding, receiving and producing steps in response to a request to produce the validation report. This is not a plausible result of combining Ogbuji and Harold and not one motivated by the Examiner's rationale.

The combination does not produce the claimed method. First, Ogbuji does not teach producing editable values after the second transformation, the Examiner's second transformation being the one that produces the validation report. Second, there is no suggestion of producing an updated validation report in response to an exchange of character strings. Third, Harold's wildcards are not responsive to a character string and are presumably applied during the first or second transformation, not after the second transformation. (Frankly, it is difficult to understand how the Examiner envisions combining wildcards with validation reports ...)

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The proposed motivation is not supported by evidence and does not motivate a combination that would read on the claimed method. It is fundamental, as indicated in MPEP Section 2143.01, that the Examiner rely on some evidentiary quality suggestion from one of the references to modify Ogbuji:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The MPEP cites *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to an examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available

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to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The outcomes of cases decided even before *In re Lee* make it clear that real evidence is required to support an asserted teaching, suggestion or motivation to modify a reference to support an obviousness finding. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (rev'd finding of obviousness, as "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) (aff'd patent not invalid, as no suggestion to modify the '989 patent with regard to non-metallic fibers). There is no evidence of a suggestion to modify Ogbuji's validation reporting to read on the claimed method.

The Examiner argues that modification of Ogbuji would have been motivated "since it would have allowed a user to easily generate separate validating stylesheets for separate nodes within a document." OA, at 13. But this is a statement of the *result* that the Examiner envisions from combining the references, attempting to use the claim as a blueprint (20-20 hindsight), which is impermissible. 2-5 Chisum on Patents § 5.03 [2][c] n. 29 (2005 Lexis version); e.g. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' "). It is not an evidentiary quality suggestion to modify Ogbuji, nor does it produce a combination that would read on claim 30.

The argued motivation is orthogonal to claim 30. It is unclear why the Examiner thinks that "easily generat[ing] separate validating stylesheets for separate nodes within a document" would read on claim 30. Perusal of the specification will reveal an

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embodiment in which a quotation is produced in response to a request for quotation (application [0056] at 36,), using a simple GUI-based editor and a declarative transformation between the documents. The proposed motivation to produce multiple validating spreadsheets is unrelated to claim 30.

Therefore, claim 30 should be allowable over Ogbuji in view of Harold.

Claims 31-37

Claims 31-37 are rejected on the same grounds as claims 2-8, respectively. Applicants fully and persuasively traversed those rejections above and incorporate their traversals by reference. For the reasons stated above, claims 31-37 should be allowable over Ogbuji in view of Harold.

Claims 38-39

Claims 38-39 include the limitations:

wherein the specified document type corresponds to a schema, further including validating the updated resulting document against the schema

wherein the specified document type and a chosen trading partner correspond to a set of business processing rules, further including validating the updated resulting document against the set of business processing rules

These limitations are not found in Ogbuji in view of Harold. There is no notion in the references of taking into account the chosen trading partner when selecting business processing or validation rules.

Therefore, claims 38-39 should be allowable over Ogbuji in view of Harold.

Claims 40-42

Claims 40-42 are rejected on the same grounds as claims 12 and 22.

Applicants fully and persuasively traversed those rejections above and incorporate their traversals by reference. For the reasons stated above, claims 40-42 should be allowable over Ogbuji in view of Harold.

Applicants respectfully submit that claims 30-42 should be allowable over Ogbuji in view of Harold.

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CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims, in light of these amendments.

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Respectfully submitted,



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